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10/575,001

04/06/2006

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7017

7590 03/13/2009
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EXAMINER

PEPITONE, MICHAEL F

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/575,001 | Applicant(s) UEDA ET AL. | |
| | Examiner MICHAEL PEPITONE | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/19/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13, 15-20, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ota *et al.* (US 2003/0055179).

Regarding claim 10 and 12-13: Ota *et al.* teaches a biodegradable polyolefin block copolymer (abstract) comprising a diblock copolymer containing 97.3% lactide and 2.74% polypropylene {as calculated by examiner} (§ 2443-2454, 2474-2478).

Regarding claim 11: Ota *et al.* teaches the basic claimed composition [as set forth above with respect to claim 10].

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents and was prepared under similar conditions. Therefore, the claimed effects and physical properties, i.e. a total light transmittance of not higher than 60%, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

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Regarding claims 15-16: Ota *et al.* teaches inorganic fillers, specifically layered silicates (¶ 195-204, 1695-1698, 1700-1705), in an amount of 0.01 to 300 parts by weight (¶ 7111).

Regarding claims 17-20 and 22-23: Ota *et al.* teaches molded products (¶ 1721-1723; 2474-2478, 2474-2477).

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Ota *et al.* (US 2003/0055179).

Regarding claim 24: Ota *et al.* teaches a method for preparing a biodegradable polyolefin block copolymer resin composition (abstract) comprising blending [in an extruder at 200 °C]: 10 wt% of a diblock copolymer containing 97.3% lactide and 2.74% polypropylene {as calculated by examiner}; 60 wt% polylactic acid; and 30 wt% propylene/ethylene copolymer (¶ 2443-2454, 2474-2478). Ota *et al.* teaches the melt flow rate (230 °C, 2.16 Kg) of the olefin block copolymer is in the range of 0.05 to 100 g/10 min (¶ 1485) {corresponding to MFR of 0.005 to 1000 g/10 min for polylactide (0.1 to 10 ratio) [MFR of 2.5 to 250 for PLA in ex. 60]}. {While the MFR of PLA is not provided, the examiner takes the position that polylactide would have a MFR within the range of 0.005 to 1000 g/10 min to afford a 0.1 to 10 ratio}

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota *et al.* (US 2003/0055179) as applied to claim 10 above, and further in view of Ryan *et al.* (US 6,506,873).

Regarding claim 14: Ota *et al.* teaches the basic claimed composition [as set forth above with respect to claim 10].

Ota *et al.* does not teach 0.1 to 30 wt% of an epoxy containing additive. However, Ryan *et al.* teaches degradable polylactide /polypropylene composition (1:15-25; 34:10-40:25) comprising epoxy containing additives, specifically 0.1 to 0.5 wt% epoxidized multifunctional oils (8:29-46), and 1 to 10 wt% epoxide plasticizers (9:13-38). Ota *et al.* and Ryan *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of degradable polylactide /polypropylene compositions. At the time of invention a person of ordinary skill in the art would have found it obvious to have 0.1 to 0.5 wt% epoxidized multifunctional oils and/or 1 to 10 wt% epoxide plasticizers, as taught by Ryan *et al.* in the invention of Ota *et al.*, and would have been motivated to do so since Ryan *et al.* suggests that

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epoxidized multifunctional oils provide reduced viscosity and increased melt strength (8:33-36), and epoxide plasticizers are non-volatile, non-toxic, and biodegradable (9:26-28).

Regarding claim 21: Ota *et al.* teaches molded products (§ 1721-1723; 2474-2478, 2474-2477).

Response to Arguments

Applicant's arguments with respect to claims 10-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

MFP
9-March-09